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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/627,253	07/28/2000	John R. Mason	1322/40/2	2388

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EXAMINER
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NGUYEN, TOAN D

ART UNIT	PAPER NUMBER
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2665

DATE MAILED: 11/22/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	09/627,253	MASON ET AL.
	Examiner Toan D Nguyen	Art Unit 2665

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1) Responsive to communication(s) filed on 28 July 2000.

2a) This action is **FINAL**.      2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4) Claim(s) 1-60 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) Claim(s) 42-60 is/are allowed.

6) Claim(s) 1-28 and 30-41 is/are rejected.

7) Claim(s) 29 is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on 18 August 2000 is/are: a) accepted or b) objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) The proposed drawing correction filed on \_\_\_\_\_ is: a) approved b) disapproved by the Examiner.

    If approved, corrected drawings are required in reply to this Office action.

12) The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All b) Some \* c) None of:

- Certified copies of the priority documents have been received.
- Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
- Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a)  The translation of the foreign language provisional application has been received.

15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>5-11</u> .	6) <input type="checkbox"/> Other: _____

## **DETAILED ACTION**

### ***Information Disclosure Statement***

1. The information disclosure statement filed on December 04, 2000 fails to comply with 37 CFR 1.98(a)(2), which requires a legible copy of each U.S. and foreign patent; each publication or that portion which caused it to be listed; and all other information or that portion which caused it to be listed. It has been placed in the application file, but the information referred to therein has not been considered.

### ***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

4. Claims 1-4, 6-22, 24-28, 30-34 and 39-41 are rejected under 35 U.S.C. 103(a) as being unpatentable over Donovan et al. (U.S. Patent 6,453,034 B1) in view of Kung et al. (U.S Patent 6,252,952 B1).

For claims 1, 6, 11-15, 18, 22 and 25, Donovan et al. disclose method of and system for extending internet telephony over virtual private network direct access lines comprising:

- (a) receiving a signaling system seven (SS7) message in response to a telephony-related action performed by an end user (figure 3, col. 3 lines 4-7);
- (b) in response to receiving the SS7 message, formulating an internet protocol (IP) message for updating presence information regarding the end user managed by a presence server (col. 3 lines 4-12); and
- (c) transmitting the IP message to the presence server over an IP network (col. 3 lines 23-31).

However, Donovan et al. do not disclose updating presence information regarding the end user managed by a presence server. In an analogous art, Kung et al. disclose updating presence information regarding the end user managed by a presence server (col. 9 line 39 to col. 11 line 6 and col. 38 lines 4-5). One skilled in the art would have recognized a server that is provided by a call manager module to use the teachings of Kung et al. in the system of Donovan et al. Therefore it would have been obvious to one of ordinary skill in the art at the time invention, to use the server that is provided by a call manager module as taught by Kung et al. in Donovan et al.'s system with the motivation being to provide a centralized call control center for supporting call-set-up and tear-down in the broadband network (col. 9 lines 40-42).

For claim 2, Donovan et al. disclose a PSTN telephone and the signaling system seven message is an IAM message (col. 3 line 62 and col. 4 line 4-5).

For claim 3, Kung et al. disclose the telephony-related action includes entering DTMF digits using a PSTN telephone handset after a call has been established, the DTMF digits forming a code for instructing an end office to formulate the SS7 message (col. 21 line 42).

For claims 4 and 28, Kung et al. disclose the SS7 message is a transaction capabilities application part (TCAP) message containing presence information for the end user (col. 13 lines 30-40).

For claims 7, 16 and 24, Donovan et al. disclose formulating an IP message includes formulating a session initiation protocol (SIP) message (col. 3 lines 9-10).

For claims 17 and 26, Donovan et al. disclose wherein receiving an IP message includes receiving an instant messaging and presence protocol (IMPP) message (col. 3 lines 46-60).

For claims 18, 19, 30-33 and 39-40, Kung et al. disclose wherein obtaining the presence information from the presence database includes obtaining the presence information from a presence database located internal to the presence registration and routing node (col. 10 line 54 to col. 11 line 6).

For claim 20-21, 34 and 41, Kung et al. disclose sending a second message to an accounting and billing system (col. 14 lines 28-44).

For claim 27, Donovan et al. disclose the SS7 message is an ISDN user part (ISUP) message (col. 3 lines 5-7 and col. 3 lines 17-20).

5. Claims 5, 23 and 35-38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Donovan et al. (U.S. Patent 6,453,034 B1) in view of Kung et al. (U.S Patent 6,252,952 B1) further in view of Miller et al. (U.S. Patent 6,324,183 B1).

For claims 35-38, Kung et al. in view of Donovan et al. disclose:

- (a) an advanced database communication module for receiving an IP-encapsulated presence-server-compatible message for determining presence information for an entity (col. 10 line 54 to col. 11 line 6);
- (b) a presence server message processor for forwarding the presence-server-compatible message to a presence server for determining the presence information (col. 10 line 10 to col. 11 line 6).

However, Kung et al. in view of Donovan et al. do not disclose receiving an IP-encapsulated and a presence server message processor. In an analogous art, Miller et al. disclose an IP-encapsulated (col. 16 lines 48-50) and a presence server message processor (figure 9, col. 3 lines 7-10). One skilled in the art would have recognized an IP-encapsulated and a presence server message processor to use the teachings of Miller et al. in the system of Donovan et al. Therefore it would have been obvious to one of ordinary skill in the art at the time invention, to use the IP-encapsulated and the presence server message processor as taught by Miller et al. in Donovan et al.'s system with the motivation being to provide routing SS7 message to internet protocol (IP) (col. 16 lines 36-40).

For claim 5, Miller et al. disclose a home location register (HLR) and a visitor location register (VLR) (col. 3 lines 55-56).

For claim 23, Miller et al. disclose receiving an advanced database communication module for encapsulating the presence-server-compatible message in an IP packet and transmitting the IP packet to a presence server over an IP network (col. 16 lines 48-50).

***Allowable Subject Matter***

6. Claim 29 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

7. Claims 42-60 are allowed.

***Reasons For Allowance***

8. The following is an examiner's statement of reasons for allowance:

Regarding to claim 42, the prior art fails to teach a combination of the steps of: a computer program product comprising computer-executable instructions embodied in a computer-readable medium for performing steps comprising:

- (a) receiving a signaling system seven (SS7) message in response to a telephony-related action performed by an end user;
- (b) in response to receiving the SS7 message, formulating an internet protocol (IP) message for updating presence information regarding the end user managed by a presence server; and
- (c) transmitting the IP message to the presence server over an IP network, in the specific combination as recited in claim 42.

Regarding to claim 51, the prior art fails to teach a combination of the steps of: a computer program product comprising computer executable instructions in a computer-readable medium for performing steps comprising:

- (a) receiving, at a presence registration and routing node, an IP message for determining presence information for an entity;

- (b) formulating a query to a presence database for obtaining the presence information;
- (c) obtaining the presence information from the presence database based on the query; and
- (d) forwarding the presence information to an end user, in the specific combination as recited in claim 51.

***Contact Information***

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Toan D Nguyen whose telephone number is 703-305-0140. The examiner can normally be reached on Monday- Friday (7:00AM-4:30PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Huy Vu can be reached on 703-308-6602. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9314 for regular communications and 703-872-9314 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-9600.

*TN*  
T.N.



ALPUS H. HSU  
PRIMARY EXAMINER